

REMARKS

In the Office Action, the Examiner rejected claims 1-20. By this paper, Applicants amended claims 1, 3, 8-15, and 19-20 for clarification of certain features. These amendments do not add any new matter. Upon entry of these amendments, claims 1-20 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections under 35 U.S.C. § 101

The Examiner rejected claim 9 under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Specifically, the Examiner stated that the claim does not define a “computer-readable medium.” Although Applicants do not necessarily agree with the Examiner, Applicants have amended claim 9. In view of the foregoing amendments, Applicants respectfully request that the Examiner withdraw the rejection of claim 9 under 35 U.S.C. § 101.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-20 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,195,091 (the “Harple reference”) in view of U.S. Patent No. 6,785,410 (the “Vining reference”). Applicants respectfully traverse this rejection.

Legal Precedent and Guidelines

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). In addressing obviousness determinations under 35 U.S.C. § 103, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007), reaffirmed many of its precedents relating to obviousness including its holding in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In *Graham*, the Court set out an objective analysis for applying the statutory language of §103:

Under §103, the scope and content of the prior art are to be determined, differences between the prior art and the claims at issue are to be ascertained, and the level of ordinary skill in the pertinent art are to be resolved. Against this background the obviousness or non-obviousness of the subject matter is to be determined. Such secondary considerations as commercial success, long-felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *KSR, slip op.* at 2 (citing *Graham*, 383 U.S. at 17-18).

In *KSR*, the Court also reaffirmed that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 14. In this regard, the *KSR* court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 14-15. Traditionally, to establish a *prima facie* case of obviousness, the CCPA and the Federal Circuit have required that the prior art not only include all of the claimed elements, but also some teaching, suggestion, or motivation to combine the known elements in the same manner set forth in the claim at issue. *See, e.g., ASC Hospital Systems Inc. v. Montifiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (holding that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination.); *In re Mills*, 16 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 1990) (holding that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination). In *KSR*, the court noted that the demonstration of a teaching, suggestion, or motivation to combine provides a “helpful insight” in determining whether claimed subject matter is obvious. *KSR, slip op.* at 14.

Furthermore, the *KSR* court did not diminish the requirement for *objective* evidence of obviousness. *Id.* at 14 (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); see also, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on *objective evidence of record*).

Further, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

The cited references, taken alone or in hypothetical combination, fail to teach or suggest features recited by independent claims 1, 9, 15, and 20.

Turning to the claims, the present independent claims 1, 9, 15, and 20 comprise *routines stored on an application server* that are “useful for at least one of *processing or analyzing an image data set*.”

The cited references, taken alone or in hypothetical combination, fail to teach or suggest that *routines are stored on an application server*, as recited by independent claims 1, 9, 15, and 20. In contrast to the present claims, the Harple reference discloses a system with the “capability of sending stored *[t]ext* to one or more members of the conference.” Harple, col. 5, lines 34-35. (Emphasis added). The Examiner erroneously equated the recited stored routines of the present claims to the storage and display of text messages data disclosed in the Harple reference. Office Action, p. 3. However, having routines stored on an application server is different from a collaborative computing apparatus with the capability of text messaging. While the Harple reference indicates that the text messages are shared, the Harple reference does not appear to indicate that routines, for text messaging or otherwise, are similarly shared. Indeed, Applicants are of the opinion that such text messaging *routines* as suggested by the Harple reference are typically located and stored on each client, not distributed by an application server. Furthermore, since text messages sent by the text tool application module of the Harple reference are “displayed in the text tool window on the display of each recipient,” one would assume that the text messaging “routines” are stored on the devices of individual conference session participants rather than on an application server. Harple, col. 5, lines 37-39. The issue of where such routines are stored in a network may affect the network’s functionality and usage. Thus, at least one aspect of the present claims is missing from the cited combination of references.

Furthermore, the Vining reference fails to obviate the deficiencies of the Harple reference. While the present claims recite routines that are “useful for at least one of

processing or analyzing an image data set,” the Vining reference discloses a method and system for “generating and communicating reports *containing an expert’s analysis* of image data.” Vining, col. 3, lines 37-39, emphasis added. However, by generating and communicating reports containing *already analyzed* image data, the Vining reference neither processes nor analyzes an image data set. Moreover, merely accessing already analyzed data reports via a computer console does not constitute routines for processing or analyzing an image data set. In view of these deficiencies among others, the cited references, taken alone or in hypothetical combination, cannot render obvious the current independent claims 1, 9, 15, and 20 and their dependent claims.

The cited references, taken alone or in hypothetical combination, fail to teach or suggest features recited by dependent claims 4, 12, and 16.

For at least the reasons previously discussed, the Harple and Vining references, taken alone or in hypothetical combination, fail to teach or suggest features recited by the present dependent claims. In addition, the present dependent claims are believed to be patentable for the subject matter they separately recite. For example, referring to claim 4, the cited references fail to teach or suggest a method for collaboratively handling an image data set comprising thin clients. The Examiner equated the thin clients of the present claims with the Harple reference’s “collaborative computing system ... user interface API, application library, [and] cell network.” Office Action, p. 4. However, the thin clients recited in the present claims are described as configured “with little or no mass storage capability or with management controls placed on the operating system to prevent local operator alteration.” Application, p. 7, lines 25-27. Further, Applicants believe that this is how one of ordinary skill in the art would interpret the term “thin client.” The purpose of using thin clients is to prevent local manipulation or customization of the system by an operator. Application, p. 8, lines 1-2. In contrast, the cited reference does not teach or suggest thin clients configured to protect the system from local manipulation or customization by an operator. The Harple reference does not describe the storage capabilities or management controls of any of the components cited

by the Examiner, nor does it discuss any other characteristics that may limit operator manipulations. For at least these reasons, claims 4, 12, and 16 are not rendered obvious by the cited references.

Improper Combination - Lack of Objective Evidence of Reasons to Modify/Combine

In addition, the Examiner has not shown objective evidence of the requisite motivation or suggestion to modify or combine the cited references to reach the present claims. As summarized above, the *KSR* court did not diminish the requirement for objective evidence of obviousness. *KSR*, *slip op.* at 14 (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); *see also*, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on *objective evidence of record*). In the present rejection, the Examiner combined the cited references based on the *conclusory and subjective statement* that it would have been obvious “to modify Harple invention according to the teaching of Vining because it provides for quick turnaround of information to the user ...” Office Action, p. 3. Accordingly, Applicants respectfully request the Examiner to produce the necessary *objective evidence* and explicit analysis of the requisite motivation or suggestion to combine the cited references, or remove the foregoing rejection under 35 U.S.C. § 103.

For at least these reasons among others, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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